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U.S. PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : RONALD A. SCHACHAR
Serial No. : 09/589,626
Filed : June 7, 2000
For : SCLERAL PROSTHESIS FOR TREATMENT OF
PRESBYOPIA AND OTHER EYE DISORDERS
Group No. : 3738
Examiner : David H. Willse

Commissioner for Patents
ATTN: OFFICE OF THE SOLICITOR
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

NOTICE OF APPEAL

Pursuant to 35 U.S.C. § 141 and 37 C.F.R. § 1.301, Applicant respectfully appeals to the United States Court of Appeals for the Federal Circuit from the Board of Patent Appeals and Interference's Decision on Appeal mailed November 23, 2004 and Decision on Request for Rehearing mailed March 24, 2005. Copies of the Decisions from which this appeal is taken are attached.

Pursuant to Federal Circuit Rule of Appellate Procedure 15(a)(1), four (4) copies of this Notice of Appeal, together with a check for the \$250.00 docketing fee required under Federal Circuit Rule of Appellate Procedure 52(a)(3)(A), are being concurrently sent to:

Clerk
U.S. Court of Appeals for the Federal Circuit
717 Madison Place NW
Washington, D.C. 20439

The Applicant respectfully invites the Solicitor, the Clerk or any other party to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com* in the event of any questions or problems. The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: May 24, 2005



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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. SCHACHAR

Appeal No. 2005-0076
Application No. 09/589, 626

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ronald A. Schachar appeals from the final rejection of claims 1 through 21. Claims 22 through 24, the only other claims pending in the application, stand allowed.

THE INVENTION

The invention relates to a prosthetic device for treating presbyopia. Representative claim 1 reads as follows:

1. A prosthesis that contacts the sclera of an eyeball, said prosthesis comprising a body having a first end and a second end, said body having a planform that expands said contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball.

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DAVIS MUNCK

THE REJECTIONS

Claims 1 through 21 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 through 7 and 12 through 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,354,331 to Schachar.

Claims 8 through 11 and 18 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachar.

Attention is directed to the main and reply briefs (filed December 23, 2003 and May 13, 2004) and to the final rejection and answer (mailed August 14, 2003 and March 9, 2004) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 101 rejection of claims 1 through 21 as being directed to non-statutory subject matter

The examiner, citing MPEP § 2105 and the 1987 Official Gazette Notice entitled "Animals-Patentability" (1077 O.G. 24),¹ considers claims 1 through 21 to be directed to non-statutory subject matter because they include within their scope a human being. By way of example, the examiner points to the language in

¹ A copy of the notice is appended to the answer.

claim 1 reciting a prosthesis "that contacts the sclera of an eyeball."

The appellant agrees that a claim directed to or covering a human being would be non-statutory under § 101, but insists that claims 1 through 21 are directed to a prosthesis per se, not a prosthesis in combination with a human being or any part thereof.

A fair reading of claims 1 through 21 supports the appellant's construction. These claims define a prosthesis per se, and the language therein referring to the sclera and other parts of the human eye merely sets forth the environment in which the claimed prosthesis is intended to be used.

Accordingly, we shall not sustain the standing 35 U.S.C. § 101 rejection of claims 1 through 21 as being directed to non-statutory subject matter.

II. The 35 U.S.C. § 102(b) rejection of claims 1 through 7 and 12 through 17 as being anticipated by Schachar

The Schachar patent discloses a prosthetic scleral expansion band for treating presbyopia by increasing the effective working range of the ciliary muscle. Figures 1 through 5, Figures 6 and 7 and Figures 8 and 9 respectively illustrate different embodiments of the expansion band. Each embodies a one-piece circular structure. Schachar teaches, however, that

[t]he scleral expansion band may also be made in a plurality of parts that can be assembled prior to use or may be installed separately to form a complete band. The band may be adjustable in circumference. For example the band may be formed from a strip of material, e.g., metal or synthetic resin, with overlapping ends so that the ends may slide past one another thereby adjusting the circumference of the band. The length of the overlap may be adjusted, for example, by means of a tangential screw mechanism to adjust the circumference of the band and thereby the amount by which the sclera is expanded [column 7, lines 1 through 12].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In the examiner's view, Schachar's unillustrated scleral expansion band formed from a strip of material having adjustable overlapping ends responds to all of the limitations in claim 1.

The appellant counters that anticipation does not lie because this unillustrated embodiment lacks a first end and a second end as recited in the claim. In this regard, the appellant submits (1) that the claim, properly construed, requires the first and second ends to be free and/or unattached, and (2) that the overlapping ends of the Schachar band effectively cease to exist when the band is formed because they are attached and fastened together.

It is well settled that during patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the present case, the recitation in claim 1 that the prosthesis body has a first end and a second end is extremely broad. The claim neither requires the first and second ends to be free and/or unattached nor excludes these ends from being fastened or attached. The appellant's argument to the contrary rests on an improper attempt to read limitations from the specification into the claim.

Thus, the appellant's position that the subject matter recited in claim 1 distinguishes over that disclosed by Schachar is not persuasive. We shall therefore sustain the standing 35

U.S.C. § 102(b) rejection of claim 1 as being anticipated by Schachar.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 2 through 7 and 12 through 17 as being anticipated by Schachar. As the appellant has not argued separately the patentability of claims 1 through 7 and 12 through 17 apart from one another, claims 2 through 7 and 12 through 17 stand or fall with representative claim 1 (In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

III. The 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21 as being unpatentable over Schachar

Claims 8 through 11 and 18 through 21 variously recite that at least one of the first and second prosthesis body ends has a top or bottom surface which is partially concave or convex. Implicitly conceding that Schachar does not disclose these features, the examiner nonetheless concludes that the provision of same to Schachar's adjustable scleral expansion band would have been obvious to suitably accommodate the overlapping ends.

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may

not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In short, the examiner has advanced speculation and unfounded assumptions, rather than the requisite evidentiary basis, to support a conclusion that the admitted differences between the subject matter recited in claims 8 through 11 and 18 through 21 and Schachar are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21 as being unpatentable over Schachar.

SUMMARY

The decision of the examiner:

- a) to reject claims 1 through 21 under 35 U.S.C. § 101 is reversed;
- b) to reject claims 1 through 7 and 12 through 17 under 35 U.S.C. § 102(b) is affirmed; and
- c) to reject claims 8 through 11 and 18 through 21 under 35 U.S.C. § 103(a) is reversed.

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Application No. 09/589,626

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
<i>Charles E. Frankfort</i>)	
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
<i>John P. McQuade</i>)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

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Appeal No. 2005-0076
Application No. 09/589,626

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BEFORE THE BOARD OF PATENT APPEALS
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MAR 28 2005

DAVIS MUNCK

Ex parte RONALD A. SCHACHAR

Appeal No. 2005-0076
Application No. 09/589, 626

ON BRIEF

MAILED

MAR 24 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 41.52, Ronald A. Schachar requests rehearing (i.e., reconsideration) of our decision rendered November 23, 2004, and more specifically, of that portion of the decision affirming the examiner's 35 U.S.C. § 102(b) rejection of claims 1 through 7 and 12 through 17 as being anticipated by U.S. Patent No. 5,354,331 to Schachar.¹

¹ In the decision, we also reversed the examiner's 35 U.S.C. § 101 rejection of claims 1 through 21 and 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21.

Consistent with our holding that claims 2 through 7 and 12 through 17 stand or fall with claim 1 for purposes of the appeal (see page 6 in the decision), the appellant's request focuses on claim 1.

In essence, the request rehashes the arguments advanced in the main and reply briefs. Such arguments are no more convincing now than they were before.

The appellant again contends that the Schachar reference is not anticipatory with respect to the subject matter recited in claim 1 because it does not meet the limitation in the claim requiring the recited prosthesis to comprise "a body having a first end and a second end." The relevant portion of the Schachar disclosure (see column 7, lines 1 through 12) describes a prosthesis in the form of a scleral expansion band comprising a strip of metal or synthetic resin having overlapping ends that are slidable past one another by means of a tangential screw mechanism to adjust the circumference of the band and thus the amount by which the sclera is expanded. The appellant submits that this band constitutes a closed circular ring which does not have first and second ends because the overlapping ends of the strip cease to exist after the scleral expansion band is formed.

According to the appellant, claim 1 is "directed to a scleral prosthesis that is not in the form of a closed circular ring" (request, page 3) and would be met by Schachar only if the band disclosed therein were modified or adjusted by being broken up into separate segments. The appellant urges that Schachar does not teach, suggest or provide an enabling disclosure for such a modification.

These arguments fail due to the broad scope of claim 1. As pointed out in the decision,

the recitation in claim 1 that the prosthesis body has a first end and a second end is extremely broad. The claim neither requires the first and second ends to be free and/or unattached nor excludes these ends from being fastened or attached. The appellant's argument to the contrary rests on an improper attempt to read limitations from the specification into the claim [page 5].

Claim 1 also does not exclude the prosthesis recited therein from being in the form of a closed circular ring. The subject limitation in the claim simply calls for the recited prosthesis to comprise "a body having a first end and a second end." Schachar's adjustable prosthesis clearly comprises such a body in the form of the strip of material having first and second ends. These ends do not cease to exist even when the strip assumes its operative configuration. Hence, the Schachar scleral expansion

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band, without any modification or adjustment thereto, fully meets the terms of the claim including the recitation of a body having a first end and a second end.

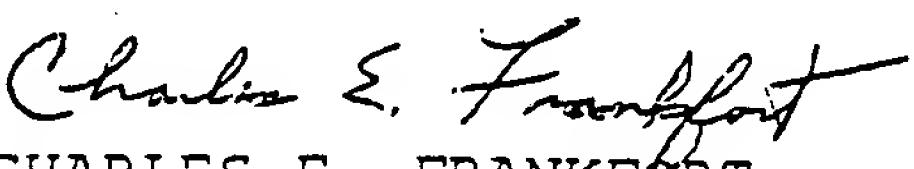
For these reasons, the arguments advanced in the appellant's request for rehearing are not persuasive of any error in our decision.

SUMMARY

In summary, we have reconsidered our decision to the extent requested by the appellant, but decline to make any changes therein.

DENIED


IRWIN CHARLES COHEN)
Administrative Patent Judge)


CHARLES E. FRANKFORT) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND INTERFERENCES


JOHN P. MCQUADE)
Administrative Patent Judge)

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NOTICE OF RULE CHANGE

Attention is drawn to the fact that the Rules of Practice before the Board of Patent Appeals and Interferences will change effective September 13, 2004. The new rules are set forth at 69 Federal Register 49960, which may be accessed via the internet at <http://www.uspto.gov//web/offices/com/sol/notices/69fr49960.pdf>.

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